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The Rejections under 35 U.S.C. § 103(a)

The Takayama Rejection

The examiner maintains the rejection of claims under 35 U.S.C. § 103(a) as unpatentable over Takayama. She notes Takayama describes the manufacture of a cylindrical monolithic open pore ceramic boron nitride article of manufacture from particulate boron nitride and subsequently impregnates it with a water/superabsorbent polymer mixture. She concludes "[t]he ceramic bodies in combination with the superabsorbent polymers still function as a lubricating material." (April 25, 2008 Examiner's Answer, p. 6, lines 1-2.), in an attempt to imply that the patentee ascribes lubricity to the monolithic boron nitride, however, the reference is mute on this point, so the argument begs the question. Takayama mentions nothing about boron nitride being used as a lubricating material, but rather ascribes lubricity to the water-superabsorbent mixture taken up by the open pores in the monolithic boron nitride, and even notes that by adjusting the porosity of the monolith to change the absorbency of the water superabsorbent mixture, the lubricity of the article changes. (Takayama, col. 4, lines 33-43.)

The Rejection based on Johnson and Obayashi

Appellant distinguishes Johnson and Obayashi et al. ("Obayashi") for the same reason set out in the Brief in Chief. The Examiner's Answer of April 25, 2008 acknowledges Johnson's gelled corrosion inhibitor does not comprise a lubricant as claimed by appellant but argues that this shortcoming merely amounts to a failure to teach the intended use of appellant's lubricant composition and does not differentiate the claimed composition per se.

The examiner also acknowledges that Johnson's corrosion inhibitor, which contains a superabsorbent polymer, fails to teach a superabsorbent polymer that absorbs more than 100 times its weight in water, and therefore looks to Obayashi for this teaching, even though Obayashi does not teach the use of superabsorbent polymers in corrosion inhibitors. (Obayashi, Col. 1, lines 11-17.)

Decisions of the Court of Appeals for the Federal Circuit define the difference between a claim limitation and a statement of intended use. Here, appellant claims the invention as a lubricant composition which comprises a claim limitation that distinguishes the invention from the references applied by the examiner to reject the claims. The description of the composition as a lubricant composition is not a statement of intended use.

The Court of Appeals for the Federal Circuit requires the examiner to view the entire prosecution record to make this determination, as in Poly-America LP v. GSE Lining Tech., Inc., 338 F.3d 1303, 72 USPQ 2d 1685, (Fed. Cir. 2004), where they found after a review of the whole record, the term "blown-film" in the preamble of the claim did "not state a purpose or an intended use of the invention, but rather discloses a fundamental characteristic of the claimed invention that is properly construed as a limitation of the claim...." Poly-America LP Inc., 338 F.3d at 1310, 72 USPQ 2d at 1689. (Emphasis added.)

Similarly, the Court in considering a claim for the treatment or prevention of pernicious anemia in humans by administering a vitamin composition to "a human in need thereof," found that this preamble did not merely amount to a statement of effect that might or might not be desired or appreciated, but rather comprised a statement of the intentional purpose for use of the composition. The Court held, that properly interpreted, the claim regarding the vitamin composition required it to be administered to a human with a recognized need to treat or prevent pernicious anemia. Jansen v. Rexall Sundown, Inc., 342 F.2d 1329, 1333-34, 68 USPQ2d 1154, 1158 (Fed.Cir., 2003)

A "preamble may provide context for claim construction, particularly, where [the preamble] . . . forms the basis for distinguishing the prior art in the patent's prosecution history." Metabolite Labs, Inc. v. Corp. of Am. Holdings, 370 F.3d 1354, 1358-62, 71 USPQ2d 1081, 1084-87 (Fed. Cir. 2004). Stated otherwise, "clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble, to define, in part, the claimed

invention." Catalina Mktg. Intl. v. Coolsavings.com, Inc., 283 F.3d 801, 808-809, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002)

The appealed claims relate to a "lubricating composition of matter" and as such this preamble provides context for claim construction in order to distinguish the prior art which thereby transforms the preamble into a limitation.

The term "lubricating composition of matter" in the claims is therefore directly analogous to the term "blown-film" in the preamble of the claim considered by the Court of Appeals for the Federal Circuit in Poly-America LP (supra) in that it does "not state a purpose or an intended use of the invention, but rather discloses a fundamental characteristic of the claimed invention that is properly construed as a limitation of the claim. . ." (Poly-America LP, 338 F.3d at 1310, 72 USPQ 2d at, 1689 (Emphasis added.)

Here, appellant uses the preamble recitation of a lubricating composition of matter to distinguish the prior art Johnson gelled corrosion inhibitor inter alia and accordingly it provides "context for claim construction, particularly, where. . . that preamble's statement of intended use forms the basis for distinguishing the prior art in the patent's prosecution history." Metabolite Labs. Inc. v. Corp. of Am. Holdings, 370 F.3d 1354, 1358-62, 71 USPQ2d 1081, 1084-87 (Fed. Cir. 2004) Also, appellant clearly relies "on the preamble. . . to distinguish the claimed invention from the prior art [Johnson reference inter alia, and] transforms the preamble into a claim limitation because such reliance indicates use of the preamble, to define, in part, the claimed invention." Catalina Mktg. Intl., 283 F.3d at 808-809, 62 USPQ2d at 1785.

The reference in the claims to a "lubricating composition of matter" should therefore be construed as a claim limitation that distinguishes the prior art relied on by the examiner, especially the Johnson gelled corrosion inhibitor.

Appellant does not dispute that Johnson discloses a gelled corrosion inhibitor or that Obayashi describes a polymer for use in water absorbing applications where the polymer absorbs from 400 to 800 times its weight in water. The references, however, must provide more

than that to support an obviousness rejection, namely a motivation, suggestion or teaching for combining them under 35 U.S.C. § 103 (a) for the purpose of an obviousness rejection. This motivation, suggestion or teaching is lacking since Johnson does not disclose water absorbing applications of Obayashi and Obayashi does not disclose corrosion inhibitor applications of Johnson. In fact, the references taken together would lead a person of ordinary skill in the art away from appellant's invention in that a person in the art of water absorbing polymers would not look to the corrosion inhibitors to address water absorption and vice-versa. The examiner, however, has combined their teachings in an attempt to include the corrosion inhibitors of Johnson with the polymers of Obayashi.

When using the combination of teachings of Johnson and Obayashi, the examiner "has to point to some teaching, [or] suggestion. . . in the prior art to select and combine the references that . . . [she] relied on to show obviousness." In re Lee, 227 F.3d 1338, 61 U.S.P.Q. 1430, 34 (Fed. Cir., 2002) (emphasis added). "When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to select and combine the references relied on as evidence of obviousness... 'the central question is whether there is a reason to combine references.'" Lee, 61 U.S.P.Q. at 1435 (emphasis added) (citation omitted). In re Kahn, No. 04-1616, Fed. Cir. March 22, 2006. The references have to provide some motivation for the skilled artisan to combine their teachings. Id.

The combination of references does not make appellant's invention obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01 citing In re Mills, 918 F.2d 680, 16 U.S.P.Q. 2nd 1430 (Fed. Cir. 1990). In addition, there must be some reasonable expectation of success (M.P.E.P. § 2143.02, citing In re Merck & Co., Inc. 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986)) and that some advantage or expected beneficial result would have been produced by their combination. (M.P.E.P. § 2144 citing In re Sernaker, 702 F.2d, 989, 994-95, 217 U.S.P.Q. 1, 5-6 (Fed. Cir. 1983)). Lastly, the prior art references must

teach or suggest all of appellant's claim limitations. (M.P.E.P. §§ 2143 and 2143.03, and In re Royka, 490 F. 2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974) cited in M.P.E.P. §2143.03.)

The Examiner has not pointed to anything in the cited references that would lead a person with ordinary skill in the art to combine their teachings. Johnson and Obayashi fail to point to some teaching or suggestion in the prior art to select and combine the references to show obviousness, evidence relevant to select and combine the references relied on as evidence of obviousness, fail to provide a reason to combine references, some motivation for the skilled artisan to combine their teachings, the desirability of the combination, some reasonable expectation of success, or some advantage or expected beneficial result would have been produced by their combination

What then motivates the skilled artisan to use a superabsorbent polymer that absorbs more than 100 times its weight in water in the gelled corrosion inhibitor of Johnson in order to produce a lubricant composition? The references cited by appellant in the written description show the art contains teachings of superabsorbent polymers that absorb greater than about 100 times their weight in water, as well as extensive disclosures of lubricant materials and technology. Where then, in all of these references, as well as Johnson and Obayashi can a skilled artisan find a teaching, suggestion, or motivation to pick and chose from them, and then combine the pieces to arrive at applicant's invention, that broadly comprises a lubricant in combination with a superabsorbent polymer that absorbs greater than about 100 times its weight in water? Applicant submits the skilled artisan couldn't without applicant's disclosure in front of them.

A 35 U.S.C. § 103 rejection cannot stand if it amounts to taking applicant's "claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

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Conclusions


Appellant requests the Board to reverse the examiner in all respects and remand the application to the examiner for the issuance of a Notice of Allowance.

Respectfully submitted,

THE LAW OFFICES OF ROBERT J. EICHELBURG

Dated: June 16, 2008

By:


Robert J. Eichelburg

CERTIFICATE OF FACSIMILE TRANSMISSION PURSUANT TO 37 C.F.R. § 1.6 (d)

I hereby certify that the foregoing Brief on Appeal, and the attached Terminal Disclaimer and FORM PTO 2038 is being transmitted pursuant to 37 C.F.R. § 1.6(d) by facsimile to The United States Patent and Trademark Office, facsimile telephone number (571) 273-8300 on the date indicated below.

Dated: June 16, 2008

By:


Robert J. Eichelburg